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In re Application of
CRITTEN et al.
Application No.: 10/510,403
PCT No.: PCT/GB03/01493
Int. Filing Date: 04 April 2003
Priority Date: 05 April 2002
Attorney's Docket No.: 18305-002US1
For: USER AUTHENTICATION FOR
COMPUTER SYSTEMS

DECISION ON
PETITION
UNDER 37 CFR 1.47(a)

This is a decision on Applicant's "Renewed Petition under 37 CFR 1.47(a)", filed 21 February 2007 to permit petitioner (applicant) to file the above-captioned application on behalf of the non-signing inventors James Edward Charlesworth and Peter Green. Applicant requests a one month extension of time, which is granted.

BACKGROUND

On 04 April 2003, applicant filed international application No. PCT/GB03/01493 which claimed a priority date of 05 April 2002, and which designated the United States. A copy of the international application was communicated to the United States by the International Bureau on 23 October 2003.

On 05 October 2004, prior to the expiration of the 30 month period from the priority date, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, basic national filing fee.

On 11 March 2005, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS indicating that the oath or declaration of the inventor must be furnished within two months from the mail date of the notice or the application would be abandoned. Extensions of time were available.

On 11 October 2005, petitioner filed a petition requesting that the above-identified application be accepted under the provisions of 37 CFR 1.47(b). The petition was not accompanied by a Statement of Facts under 37 CFR 1.47, based upon first hand knowledge, regarding the nonsigning inventors' refusal to sign the application. A declaration was not presented which was executed under 37 CFR 1.47(b), on behalf of the non-signing inventors.

On 03 February 2006, a decision dismissing applicant's petition was mailed indicating that applicant had failed to meet the requirements under 37 CFR 1.47(b). Petitioner's attention was directed to Manual of Patent Examining Procedure (MPEP) Section 409.03 et. seq. for instruction on fulfilling the requirements of 37 CFR 1.47.

On 17 July 2006, a Notification of Abandonment was mailed indicating that applicant had failed to respond to the 905 mailed on 11 March 2005.

On 05 September 2006, applicant filed a renewed petition under 37 CFR 1.47(b) along with a request to withdraw the holding of abandonment. On 21 November 2006, a decision, vacating the Notification of Abandonment and dismissing the petition, was mailed indicating that applicant had not satisfied the requirements of 37 CFR 1.47(b).

On 21 February 2007, applicant filed a petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the requisite petition fee, (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor.

Petitioner previously provided the petition fee satisfying Item (1). With respect to Item (2), the petition includes a statement of facts signed by Victoria Bradford, a patent attorney having firsthand knowledge of the facts recited therein. The petition offers evidence to prove that the inventors James Edward Charlesworth and Peter Green refuse to sign the application papers. Ms Bradford provided copies of the correspondence indicating that a complete copy of the application papers was sent to the nonsigning inventors along with proof of delivery to the nonsigning inventors last known address. Thus, Item (2) is satisfied.

Regarding Item (3), the petition provides the last known address for each of the non-signing inventors. Item (3) is satisfied.

With respect to Item (4), Petitioner has submitted a declaration under 37 CFR 1.47(a), executed by the joint inventors on their own behalf and on behalf of the nonsigning inventors. The declaration meets the requirements of 37 CFR 1.47(a) and (b). Item (4) is satisfied.

The action taken by petitioner is sufficient to demonstrate that a *bona fide* attempt was made to present a copy of the application papers for U.S. application 10/510,403 (specification, including claims, drawings, and declaration) to the nonsigning inventors for their signatures and that Messrs. Charlesworth and Green's conduct is construed as a refusal to sign the application papers. Accordingly, it is appropriate to accord the national stage application status under 37 CFR §1.47(a).

CONCLUSION

The petition under 37 CFR §1.47(a) is GRANTED.

The U.S. Designated/Elected Office is authorized to accept the application as a 37 CFR 1.47(a) application using the declaration filed 21 February 2007. The application has an international filing date of 04 April 2003 under 35 U.S.C. 363, and a date of 21 February 2007 under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventors at their respective last known address of record. Also, a notice of the filing of this application will be published in the Official Gazette.



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UNDER 37 CFR 1.47(a)
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Dear Mr. Charlesworth:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. § 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.


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